

Remarks

The Office Action mailed August 23, 2006 has been reviewed with care. The withdrawal of U.S. Patent No. D479,146 (Manley) is noted with appreciation.

Information Disclosure Statement

A supplemental information disclosure statement accompanies this response. The purpose of the IDS is to provide more specific and detailed information regarding the structure and purpose of the Smead VIEWABLES® product cited in the August 23 Office Action.

Also included with the IDS are several specialty advertising product catalogs and a trade publication provided as background information and to show representative products available to the specialty marketing marketplace, a marketplace served by Applicant's invention. This information provides useful context for the three industry-expert declarations which accompany this response under 37 C.F.R. § 1.132 and which provide objective evidence that Applicant's invention is not obvious.

Amendments

Independent claims 1, 15 and 23 are amended to more specifically describe the relationship between the indicia and the tri-panel sleeve. Support is found in the application, for example, at page 7, lines 30-31 and page 9, lines 3-8 and Figs 1, 2, 5, 7, 9 and 10. Claim 1 deletes resilient for consistency with the other independent claims. As is apparent from the citations, no new matter is added.

Rejections under 35 U.S.C. § 103(a)

Claims 1-6, 14, 15, 17, 18 and 20-24 were rejected under 35 U.S.C § 103(a) based on U.S. Patent No. 1,232,747 (Yochim) in combination with U.S. Patent No. 5,806,147 (Sato).

Separately, claims 1-12, 14, 15 and 17-35 were rejected under 35 U.S.C § 103(a) based on the combination of Yochim, Sato and the VIEWABLES® product from Smead Manufacturing Company. Claim 13 was rejected under § 103(a) based on the foregoing references together with U.S. Patent No. 5,522,586 (Bennett). Reconsideration and withdrawal of all rejections is requested in view of the following remarks.

Obviousness is a question of law based on underlying factual inquiries including: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the prior art and the claimed invention; and (4) the extent of any objective evidence of non-obviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966); *Winner Int'l. v. Wang*, 202 F.3d 1340, 1348 (Fed. Cir. 2000); MPEP § 2141(I.) at 2100-124 (Aug 2005).

Under the present state of the law, when obviousness is based on teachings of multiple prior art references, it must be established that there is some “teaching, suggestion or motivation” that would have led a person of ordinary skill in the art to combine the relevant prior art teachings in the manner claimed. *Tec Air, Inc. v. Denso Mfg. Mach. Inc.*, 192 F.3d 1353, 1359-60 (Fed. Cir. 1999); *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). (Obviousness rejection reversed because it was improper to combine references to teach a Halloween pumpkin plastic trash bag without a teaching, suggestion or motivation to combine the references.)¹ Close adherence to the correct analysis under § 103 is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be

¹See also, *Teleflex v. KSR Intern.*, 119 Fed. Appx. 282, 285 (Fed. Cir. 2005) (currently on appeal to the U.S. Supreme Court) (not citable as precedent). *Teleflex*, involved a patent to an adjustable automobile pedal assembly support with an electronic sensor on the pedal support structure for determining the pedal position. The prior art taught all elements of the adjustable pedal as claimed except for the electronic sensor. The prior art further taught the use of electronic sensors on non-adjustable automobile pedal assemblies. The Federal Circuit reversed the District Court’s finding of obviousness under § 103 and concluded that a person of skill in the art would *not* be implicitly motivated to transfer the sensor from the non-adjustable pedal assembly to the adjustable pedal assembly. *Teleflex*, 119 Fed. Appx. at 285.

understood may prompt one to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher. *In re Dembiczak*, 175 F.3d at 999.

Neither of the two bases for rejection of Applicant's claims meets the criterion for obviousness. There are significant differences between the structure of the applied references and the binder clip sleeve device as claimed. Moreover, the reason for combining the references is not known because each applied reference is directed toward solving a problem different from the binder clip sleeve device as claimed. Finally, evidence of secondary considerations accompanying this response demonstrates that the claimed binder clip sleeve is unique and non-obvious.

All of the rejections are based primarily on a 90 year old patent from 1917 combined with elements from subsequent products. The fact that the elements of Applicant's claimed binder clip sleeve lay about in the prior art available for years to all skilled workers without suggesting anything like the claimed invention is itself evidence of non-obviousness. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1577 (Fed. Cir. 1987). Moreover, the art is crowded with many different attempts to associate information with clips of various types as noted in the Background section of the Application and art of record. (*See, e.g.*, U.S. Patent No. 1,133,388 (Merrill) which shows a single panel secured to a metal clip.) None are like Applicant's claimed device.

Turning then to Yochim, that 90 year old device is an indicator for use with paper files, binders and stencils. Yochim at col. 1, lines 9-18. Yochim permits a file or stencil to be arranged in alphabetical order or located for future use. *Id.* at col. 1, lines 13-25.

Yochim discloses a bent sheet metal part 2, a transparent "shield" 11 and a single panel "indicator card" or "strip" 13 slid between the shield portion 12 and portion 5 of sheet metal part 2. Yochim at col. 1, line 48 through col. 2, line 62. The Yochim device is said to be inserted onto the stencil or file by means of a tongue 16. Yochim at col. 2, lines 63-68. It appears that Yochim's design creates a significant risk of damaging or creasing the stencil or file material as

the gripping flanges 7, 8 are fitted over or taken off of the stencil or file because there is no means by which to spread the flanges wide apart.

Yochim differs from Applicant's invention at least because: (1) the transparent shield 11 is not a tri-panel sleeve with indicia on at least one panel as claimed;² (2) the strip 13 is not a tri-panel sleeve as claimed³; (3) the strip 13 presents information only along one side of the device which is contrary to one goal of the invention which is to increase the area for placement of indicia;⁴ (4) Yochim's bent sheet metal part is not a "binder clip" as claimed which is important because Applicant's invention is claimed for use with a binder clip⁵; and (5) there is no structure provided to open the flanges wide to avoid damaging the stencil when the device is placed on, or taken off of the stencil.

Sato shows several modified binder clip devices, including one with handles used to open the binder clip jaws. Sato, like the conventional binder clips acknowledged in the application (Application at page 1, lines 25-27), offers nothing with respect to association of indicia with a tri-panel sleeve affixed to a binder clip. This is because Sato lacks any tri-panel sleeve structure; it is apparent that Sato never considered use of a binder clip as a communication tool of any sort

²Independent claims 1, 15, 23 and 27 require indicia on at least one of the panels (claims 1, 15 and 27) or affixing indicia directly to a tri-panel binder clip sleeve (claim 23). This is structural language which distinguishes Yochim in that no indicia is on, or affixed directly to, Yochim's shield element 11.

³The Application states, "The term "sleeve" is defined herein as a part adapted to be fit over and around another part. For purposes of the invention, the part over which the sleeve is fitted is the binder clip." Application at page 3, lines 11-13. Sleeve is a structural term. Yochim's strip 13 does not meet this definition.

⁴"The sleeve advantageously provides increased area for location of indicia and permits improved viewing of the indicia from plural sides of the clipped documents." Application at page 3, lines 29-30.

⁵The Application defines a binder clip at page 1, lines 9-25 and Yochim's device does not meet this definition.

as is claimed by Applicant.

The Smead VIEWABLES product is a filing folder tab system that has nothing whatsoever to do with binder clips of any kind. Binder clips are not shown, discussed or even contemplated as part of the VIEWABLES system as is apparent from the Smead literature and patents provided with the information disclosure statement.

The VIEWABLES product is to be used with hanging folders as part of a color labeling system. Without the folders, the tabs are utterly useless (which is not the case with Applicant's invention). As shown at page 3 of the Smead "Viewables Color Labeling System" brochure provided with this Amendment, the VIEWABLES product includes a somewhat T-shaped member which, according to the VIEWABLES brochure, fits into the tab slots of any style of hanging folder. U.S. Patent No. 5,513,459 referred to in the aforementioned brochure shows a tab which is joined to a file folder by an adhesive panel. '459 patent at col. 5, lines 7-51 and Figs. 2-6. The '459 patent includes four claims granted for the combination of a simple file tab and file folder.

There is no teaching, suggestion or motivation from the references which would teach their combination other than through hindsight based on Applicant's disclosure. Yochim did not contemplate a tri-panel sleeve with indicia directly on at least one panel, instead describing a single strip 13. Yochim's "transparent shield member 11" is not a sleeve as claimed but is more properly analogous to Applicant's light-transmissive sleeve element 91 shown in the example of Figure 10 and claimed in claims 14, 22 and 26. Yochim would be a flop in the marketplace because it never contemplated use with a conventional, robust binder clip as described in the Application at page 1 and as claimed. Sato never contemplated anything more than a binder clip. The Smead VIEWABLES product shown in the brochure is directed to a wholly different set of problems involving hanging folders and attachment of a tab such folders.

If Applicant's claimed invention was obvious, why has no such device been identified in the 90 years since Yochim? *Panduit Corp.*, 810 F.2d at 1577.

The foregoing references differ materially from Applicant's device as claimed in independent claims 1, 15, 23 and 27 because none of them envisioned transforming the universally-accepted binder clip into a powerful tool for communication as has the Applicant. Applicant alone has recognized that significant value is added to the ubiquitous binder clip by combining the dependable gripping and grouping power of the binder clip with a communication medium. No applied reference teaches Applicant's combination of a tri-panel sleeve and binder clip as in independent claims 1, 15, 23 and 27. It should also be noted that no reference teaches a light-transmissive sleeve element over the tri-panel binder clip sleeve as in claims 14, 22 and 26.

Who would be interested in a product such as the claimed binder clip sleeve device? Just one example would be a professional firm interested in marketing itself to its actual and potential clients. The firm could place its firm name on a binder clip and then use the binder clip to hold together a stack of documents prepared by the firm. The person receiving the documents would be constantly reminded of the professional firm simply by looking at the binder clip. Please see the accompanying Declaration of Richard Raddatz at ¶ 6 and Declaration of Lyle Fries at ¶¶ 5-6. None of this is possible with the devices of the cited references. Applicant's invention is at least as new, useful and non-obvious as anything in Yochim, Sato and VIEWABLES. It is respectfully submitted that a *prima facie* case of obviousness has not been established.

Evidence of Secondary Considerations

Accompanying this paper are three declarations submitted pursuant to 37 C.F.R. § 1.132 which provide powerful objective evidence demonstrating the value and non-obviousness of the claimed product, particularly in the context of use as an advertising tool. The Application explicitly states that the invention may be used for advertising purposes. Application at page 3, lines 22-23 and page 14, lines 2-3.

Objective evidence of non-obviousness can be used to rebut a *prima facie* case of obviousness based on prior art references. *Tec Air.*, 192 F. 3d at 1360; MPEP § 2141(III.) at

2100-125 (“Objective evidence or secondary considerations such as unexpected results, commercial success, long-felt need, failure of others, copying by others, licensing, and skepticism of experts are relevant to the issue of obviousness and must be considered in every case in which they are present. When evidence of any of these secondary considerations is submitted, the examiner must evaluate the evidence.”) Evidence of secondary considerations may often be the most probative and cogent evidence of non-obviousness in the record and it may often establish that an invention appearing to have been obvious in light of the prior art was not. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F. 2d 1530, 1538 (Fed. Cir. 1983). Evidence of secondary considerations is to be considered as part of all the evidence, not just when the decision maker remains in doubt after reviewing the art. *Id.* 713 F. 2d at 1538-1539.

The declarants, Messrs. Raddatz, Jolly and Fries, are knowledgeable and seasoned businessmen with a collective 72 years of experience in the specialty advertising market (over 96 years of total business experience). Raddatz declaration at ¶¶ 1-4, Jolly declaration at ¶ 1-3, Fries declaration at ¶¶ 1-2. Each of the declarants has personal knowledge of the types of products available in the specialty marketing industry. Raddatz declaration at ¶4, Jolly declaration at ¶ 4, Fries declaration at ¶ 2.

These knowledgeable declarants all agree that:

- They have never previously seen a product like the binder clip sleeve in their many years of business.⁶
- The binder clip sleeve is unique.⁷
- The binder clip sleeve is valuable – there is a need for this product.⁸
- There is a clear nexus or connection between the structure of the binder clip

⁶Raddatz declaration at ¶ 7, Jolly declaration at ¶ 4, Fries declaration at ¶ 4

⁷Raddatz declaration at ¶ 10, Jolly declaration at ¶¶ 4-5, Fries declaration at ¶¶ 4-6.

⁸Raddatz declaration at ¶¶ 8-10, Jolly declaration at ¶¶ 5-6, Fries declaration at ¶¶ 5-7.

sleeve *as claimed* and the value of the binder clip sleeve. Specifically, the structure of the binder clip sleeve enables a standard binder clip to be converted to a high-quality and professional-looking communication tool.⁹

- The binder clip sleeve is expected to be a success in the marketplace, even though the product is in the earliest stages of its marketing cycle.¹⁰

Mr. Jolly sums up the non-obviousness of the invention by stating that if the binder clip sleeve technology was so “obvious” it would have been developed and sold many years ago. Jolly declaration at ¶ 7. Mr. Fries states that specialty advertising is all about finding unique ways to get the advertiser’s message out to decision makers who will purchase the advertiser’s products; Mr. Fries believes that the binder clip sleeve is such a unique communication product. Fries declaration at ¶ 6. Mr. Raddatz states that the binder clip sleeve may seem like a simple idea but it is really quite clever and unique and represents an advance and improvement over other products of which he is aware. Raddatz declaration at ¶ 8.

The binder clip sleeve technology is of sufficient value to have attracted an exclusive licensee and the technology is now the subject of a written exclusive license agreement. Raddatz declaration at ¶ 10 and at ¶¶ 5-11. The existence of a license agreement is objective evidence that the invention is not obvious by showing commercial success, long-felt need and copying by others. *Stratoflex*, 713 F. 2d at 1539; *B & H Manufacturing Inc. v. Foster-Forbes Glass Co.*, 26 U.S.P.Q.2d 1066, 1070 (N.D. Ind. 1993).

Pursuant to the written exclusive license agreement, Mr. Raddatz has initiated, and is in the early stages of, a marketing campaign, including print and internet advertising. Raddatz declaration at ¶¶ 11, 13-16. This includes establishment of a manufacturing capability. Raddatz declaration at ¶ 12. Initial reaction to the binder clip sleeve product has been positive; it is

⁹Raddatz declaration at ¶¶ 8, Jolly declaration at ¶ 5, Fries declaration at ¶ 5.

¹⁰Raddatz declaration at ¶ 11 and ¶¶ 10-16, Jolly declaration at ¶¶ 4, 6-7, Fries declaration at ¶¶ 3-4.

expected that orders will be taken in the near future and that the product will enjoy significant commercial success in the years to come. Raddatz declaration at ¶¶ 14-16.

Further reinforcing and strengthening the probative value of the secondary evidence submitted herewith is the fact that the evidence shows a clear and unmistakable nexus between the device structure as claimed and the product's early commercial success and acceptance (not to mention the fact that the device as claimed meets a long felt need that has been unfulfilled). *In re Paulsen*, 30 F.3d 1475, 1482 (Fed. Cir. 1994); *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 1027 (Fed Cir. 1985). Such secondary evidence demonstrates the non-obviousness of the invention.

Further supporting Applicant's position that the binder clip sleeve invention is non-obvious are the following four publications listed in the information disclosure statement:

- Promotional Products Business magazine, September 2006.
- 2006 Lasting Impressions Catalog, Lee Wayne Corporation.
- 4imprint Catalog, Fall 2006.
- National Pen Company Catalog, Fall 2006.

The Examiner is invited to peruse these publications. These publications are useful as general background information to show that there is a well-defined market for specialty advertising products and to provide examples of types of specialty marketing products and tchotchkes-type products currently being promoted for sale. (These publications do not show the entirety of all such products ever made and promoted.) While various clips are shown of the type that would be used to close a food product bag¹¹, there are no products shown which resemble the claimed device in any way. To quote Mr Jolly again, if the binder clip sleeve technology was "obvious" it would have been developed and sold many years ago. The fact that Applicant's

¹¹Lasting Impressions Catalog at page 42, 4imprint Catalog at pages 15 and 22, National Pen Company Catalog at page 55.

product as claimed is missing from these sources is further evidence of the uniqueness and non-obviousness of Applicant's binder clip sleeve invention.

The objective evidence from non-party witnesses and sources demonstrates that the binder clip device as claimed is a really good idea and is not obvious. Meaningful commercial success and interest is occurring even at this early stage of the marketing process. When this information is taken together with the improvements made possible by Applicant's binder clip sleeve device and the shortcomings of the applied references, the conclusion that forms is that Applicant's invention represents a valuable and non-obvious improvement over the state of the art.

Request for Interview

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly **requested to call** the undersigned at the telephone number listed below.

Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this case, and any required fee, except for the Issue Fee, is to be charged to Deposit Account No. 10-0270. Kindly notify the undersigned in the event that the deposit account is debited or credited.

Respectfully submitted,

By John E. Munger January 23, 2007
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Chris Wipper
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Signature Date